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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,706	12/10/2003	Tsuncya Ikezu	UNMC 63156.1	7422
110	7590	06/28/2005	EXAMINER	
DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET SUITE 2400 PHILADELPHIA, PA 19103-2307			STUCKER, JEFFREY J	
			ART UNIT	PAPER NUMBER
			1648	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/732,706

Applicant(s)

IKEZU, TSUNEYA

Examiner

Jeffrey Stucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 4/13/05

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

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This Office Action is in response to the claims filed 10 December 2003.

The drawings are objected to because several are difficult to read. In addition, Fig. 5A lacks required sequence identifiers.

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.

Appropriate correction is required.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country,

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more than one year prior to the date of application for patent in the United States.

Claims 8-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Fujiwara et al. (5,831,058).

The claimed invention is an antibody immunologically specific for NEBR1 wherein the antibody is a polyclonal or monoclonal antibody.

Applicant indicates on page 4 of the specification and Example 1 that NEBR1 is also known as structure of the NEBR1 gene (also known as OTK18 and Ge914). The specification discloses that the NEBR1 gene is a zinc finger transcriptional regulator located on chromosome 19q13.4. Fujiwara et al. teach NEBR1/OTK18. See column 14, "Example 4" which discloses that OTK18 a zinc finger transcriptional regulator located on chromosome 19q13.4; the same location as the OTK18 zinc finger transcriptional regulator disclosed by the instant specification. The patent teaches how one can produce polyclonal and monoclonal antibodies that specifically bind to proteins produced by the disclosure. Thus, the instant invention is anticipated by Fujiwara et al.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 11-13 are rejected under 35 U.S.C. § 103(a) as obvious over Fujiwara et al. (5,831,058) in view of Harlow et al. (1988).

The claims are directed to a method for identifying NEBR1 expression in a biological sample, comprising contacting said sample with a detectably labeled antibody immunologically specific for NEBR1 and determining the presence of NEBR1 expression as a function of the amount of detectably labeled

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antibody bound by the sample relative to control cells wherein said detectable label is selected from the group consisting of fluorescein, texas red and rhodamine and wherein said biological sample is selected from the group consisting of brain tissue, polymorphonuclear blood mononucleocytes, macrophages and CD4+ T cells.

The relevance of Fujiwara et al. is set forth above. This patent also teaches that NEBR1/OTK18 is found in brain tissue and is expressed ubiquitously in various adult tissues. See column 15, line 12 and column 16, lines 3-8. It also teaches that antibodies by the disclosed method can be used in assays and discrimination or indentification of the corresponding protein. See column 3, lines 57-60.

Harlow et al. teach that antibodies can be labeled by direct coupling to fluorochromes. Specific labels that are in common use are fluorescein, texas red and rhodamine. It would have been obvious to one of ordinary skill in the art at the time the invention was made to label the antibody of Fujiwara et al. with the labels of Harlow et al. to be used advantageously in assays and discrimination or indentification of the NEBR1/OTK18 gene product.

No claims are allowed.

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Papers related this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

The Group 1600 Official Fax number is: (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center representative whose telephone number is (571)-272-1600.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Stucker whose telephone number is (571)-272-0911. The examiner can normally be reached Monday to Thursday from 7:00am-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (571)-272-0902.


JEFFREY STUCKER
PRIMARY EXAMINER